

REMARKS

Claims 1-40 are pending in the instant application. Claims 1, 20, and 40 are independent claims, and claims 2-19, and 21-39 depend, respectively, from independent claims 1 and 20. Applicants request reconsideration of the claims in view of the following remarks.

Claims 1-40 currently stand rejected as rejected under § 103. More specifically, independent claims 1, 20 and 40 have been found to be unpatentable over USP 6,167,138 ("Shennib") in view of USP 5,729,612 ("Abel"). Applicants respectfully traverse this finding for the following reasons.

The first Office Action issued in the case found claims 1-40, as originally filed, to be obvious in light of Shennib. As noted in Applicants' previous responses, Applicants' invention differs from the Shennib reference in several key respects. Shennib merely discloses a pair of intra-canal prostheses being placed in the two ear canals (...) to deliver acoustic stimuli and a probe measurement system (...) measuring the in the ear response conditions near the tympanic membrane during all hearing evaluation (...) for providing a common reference point for correlating responses in (...) hearing evaluation conditions. ('138 patent , col. 9, Ins. 15-22.) As such, Shennib discloses taking measurements during a hearing evaluation (test), and not prior to automatic initiation of the hearing test. Moreover, Shennib does not disclose automatically starting a hearing test after at least one condition associated with the position of a test probe in the ear of a subject is satisfied.

The current Office Action concedes that the claims in their present form are not obvious in light of Shennib, noting that "Shennib does not clearly teach pre-test and automatically starting a hearing test after the at least one condition is satisfied." (Office Action, dated Dec. 15, 2004, at p. 3.)

In attempts to remedy this deficiency, the Office Action has now included a second reference, the Able reference. However, in order to establish a *prima facie* case of obviousness in light of multiple references, there must be some motivation to combine the Shennib and Able references. See MPEP § 2142 ("First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching."). The examiner bears the initial burden of factually supporting any *prima facie*

conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The Able reference generally relates to determining the soundfields generated by certain sounds. More specifically, the Able reference derives a head-related transfer function (HRTF) by measuring the acoustic levels that occur at different points on the human head to determine the function of both frequency and relative orientation between the head and the source of the sound field. ('612 patent, col. 2, Ins. 1-5.) In measuring the acoustic levels, the Able system requires acoustic input transducers to be placed at or near the surface of the human test subject (*id.* at col. 6, Ins. 38-39). The Able system generates a signal which is measured by the input transducers. Provided the measurements are valid (an invalid measurement may take place if the subject moves during the test), the Able system is able to derive a HRTF. Thus, much like the Shennib reference, the Able reference is not related to testing a patient's hearing, as claimed in the present application.

"A prior art references must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." MPEP § 2141.02. Applicants respectfully submit that the Office Action's attempt to pick and choose a single isolated element from Able and shoehorn it into Shennib ignores the references in their entireties and is therefore improper. There simply is no suggestion in either reference to combine the two references to arrive at the invention recited in the claims of the present application. Even if one assumed that the combination did teach the limitations recited in the claims, there simply is no motivation to combine these references.

"In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is **not** whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." MPEP § 2141.02. The law is well settled that "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion or incentive to do so." *ACS Hospital Sys., Inc. v. Montfiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929 (Fed. Cir. 1984). It is not permissible to

pick and choose among the individual elements of assorted prior art references to re-create the claimed invention, but rather “some teaching or suggestion in the references to support their use in the particular claimed combination” is needed. *Symbol Tech., Inc. v. Opticon, Inc.* 935 F.2d 1569, 1576, 19 USPQ2d 1241 (Fed. Cir. 1991).

In *Ex parte Hiyamazi*, the Board of Patent Appeals and Interferences reversed a rejection based on a combination of references, stating, in part:

Under 35 USC § 103, where the Examiner has relied upon the teachings of several references, the test is whether or not the reference viewed individually and collectively would have suggested the claimed invention to the person possessing ordinary skill in the art. Note *In re Kaslow*, 707 F.2d 1366, 107 USPQ 1089 (Fed.Cir. 1983). It is to be noted, however, that citing references which merely indicate the isolated elements and/or features recited in the claims are known is not a sufficient basis for concluding that the combination of claimed references would have been obvious. That is to say, there should be something in the prior art or a convincing line of reasoning in the answer suggesting the desirability of combining the claimed invention. Note *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed.Cir. 1986).

Ex parte Hiyamazi, 10 USPQ2d 1393, 1394 (Bd. Pat. App. & Interf. 1988).

In combining Shennib and Able, the Office Action has merely picked and chosen among isolated, individual elements of separate references to re-create the Applicants' claimed invention. There is no teaching or suggestion in these references to support their use in the particular claimed combination. The proposed combination represents “the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed.Cir. 1983). Thus, at least for these reasons, the Applicants respectfully submit that the claims 1, 20 and 40 of the present application should be in condition for allowance.

Moreover, even if there was a motivation or suggestion to combine the Shennib and Able references, the two reference do not teach or suggest all the claim limitations, as required by MPEP § 2142. As the Office Action concedes, “Shennib does not clearly teach pre-test and automatically starting a hearing test after the at least one condition is satisfied,” (Office Action, dated Dec. 15, 2004, at p. 3), as is required by each of the independent claims. The Office Action states that the Able references teaches

automatically starting a hearing test after at least one pre-test condition is satisfied. In support of this position the Office Action cites FIGS. 1 and 2 and col. 15, line 55 through col. 16, line 30, which is labeled as the “Validate” step of the Able system. As illustrated in FIG. 2 of the Able reference, the Able system generates a soundfield and uses the input transducers to measure the response to the soundfield. After receiving the response, the Able system then validates the measurements to ensure that, among other things, the test subject did not move while the measurement was taken.

Accordingly, the Able reference determines whether the condition is satisfied (*i.e.*, was a valid measurement taken) **after** the measurement (test) was taken. Thus, much like the Shennib reference, Able does not clearly teach automatically starting a hearing test after the at least one pre-test condition is satisfied, as is required by each of the independent claims. Applicants respectfully submit that claims 1, 20 and 40 of the present application should be in condition for allowance for this reason as well.

Additionally, because dependent claims 4-19 and 29-38 depend from independent claims 1 and 20, respectfully, and in light of independent claims 1 and 20 being allowable over the proposed combination of references, as discussed above, the Applicants respectfully submit that rejection of the dependent claims 4-19 and 29-38 is now moot. The Applicants respectfully assert that dependent claims 4-19, and 29-38 are allowable over the cited references and request that rejection of dependent claims 4-19 and 29-38 be withdrawn.

CONCLUSION

Based on at least the foregoing, the Applicants believe that claims 1-40 are in condition for allowance. If the Examiner disagrees or has any question regarding this submission, the Applicants request that the Examiner telephone the undersigned at (312) 775-8000.

A Notice of Allowance is courteously solicited.

Respectfully submitted,

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By: Ronald Sphuler
Ronald H. Sphuler
Reg. No. 52,245

McAndrews, Held & Malloy, Ltd.
500 West Madison Street - Ste. 3400
Chicago, Illinois 60661
(312) 775-8000